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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 980,716	12.05/2001	John Christopher Padget	P 0284098	7144

909 7590 09/03/2003
PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

BISSETT, MELANIE D

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,716

Applicant(s)

PADGET ET AL.

Examiner

Travis B Ribar

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18 and 21-27 is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. This application is in condition for allowance except for the presence of claims 19-20 to an invention non-elected with traverse in Paper No. 7. Applicant is given ONE MONTH or THIRTY DAYS from the date of this letter, whichever is longer, to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

2. The groups of inventions in the present application, as defined in the previous office action, are now:

Group 1: Claims 1-13 and 21-26;

Group 2: Claims 14-18 and 27;

Group 3: Claims 19 and 20.

These changes are due to the applicant's newly added claims.

3. Claims 1-13 and 21-26 are directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 14-18 and 27, directed to the process of making or using the patentable product,

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previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined. Process claim 14-18 and 27 are hereby rejoined and fully examined for patentability under 37 CFR 1.104. Claims 19 and 20, not directed to the process of making or using the patentable product, will not be rejoined.

4. Applicant's election with traverse of group 1 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the inventions share the same general inventive concept. This is not found persuasive because groups 1 and 3 and groups 2 and 3 do not share the same special technical feature. The special technical feature of groups 1 and 2 is the so-polymerizable surfactant. The special technical feature of group 3 is the set of written instructions. The special technical feature of groups 1 and 2 is not found in group 3, and the special technical feature of group 3 is not found in groups 1 and 2. Groups 1 and 3 and groups 2 and 3 are therefore restrictable.

The requirement is still deemed proper and is therefore made FINAL.

Allowable Subject Matter

5. Claims 1-18 and 21-27 are allowed.

Response to Amendment

6. Applicant's arguments, see paper number 7, filed June 23, 2003, with respect to the claims in the present case have been fully considered and are persuasive in light of

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the applicant's newly amended claims. The rejections and objections of claims 1-13 put forth in the previous office action have been withdrawn.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fryberg et al., drawn to ink jet printing paper;

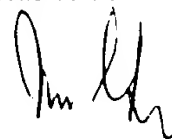
Kobayashi et al., drawn to ink jet printing paper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar
Examiner
Art Unit 1711



TBR

WEST Search History

DATE: Tuesday, August 19, 2003

Set Name Query
side by side

Hit Count Set Name
result set

DB=USPT,PGPB,JPAB,EPAB,DWPI,TDBD; PLUR=YES; OP=ADJ

L22	L1 and L21	16	L22
L21	L19 with (cationic)	392	L21
L20	L1 with L19	27	L20
L19	surfactant with S4polymerizS4	5050	L19
L18	L17 and @ad<19990922	1008	L18
L17	((L1 or L7) with coating) and S5emulsion and salt) or L16	1970	L17
L16	L15 and salt	1730	L16
L15	S5emulsion and L14	2912	L15
L14	(L1 or L7) with (paper or medium or media or substrate)	43732	L14
L13	L12 and mordant	107	L13
L12	L11 and oil	592	L12
L11	L10 and (surfactant same cationic)	899	L11
L10	L9 and surfactant	2924	L10
L9	L6 or L8	6427	L9
L8	L7 and emulsion	1819	L8
L7	ink\$1receptive or ink receptive or printable	17964	L7
L6	L1 and emulsion	5152	L6
L5	L3 and mordant	9	L5
L4	L3 and bicontinuous	0	L4
L3	L2 and (surfactant same cationic)	106	L3
L2	L1 and (micro emulsion or micro\$1emulsion)	484	L2
L1	ink jet or ink\$1jet	124923	L1

END OF SEARCH HISTORY